

REMARKS

Claims 51-62 are pending and currently under consideration in the present application. Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the prior Office Action.

1. Applicants note with appreciation that the amendments filed July 7, 2003 have been entered in full.
2. Regarding the date to which the present application may rightfully claim priority, Applicants respectfully disagree with the effective filing date suggested by the Examiner in the previous Office Action. The present application is a continuation under 37 CFR 1.53(b) of United States Serial Number 08/360,144, filed December 20, 1994. Applicants previously enclosed a copy of the Request for a Continuation under 37 CFR 1.53(b) which accompanied the present application and was filed March 3, 2000. However, the Examiner did not receive this document. Thus, Applicants enclose another copy for the Examiner's review (enclosed herewith as Exhibit 1). Applicants note that the Request properly indicated that the present application is a continuation of United States Serial Number 08/360,144, filed December 20, 1994. Additionally, the Request included an amendment to the specification to explicitly reference the application to which the present application claims priority. Accordingly, Applicants contend that the present application is a direct continuation of and properly claims priority to United States Serial Number 08/360,144, filed December 20, 1994. The effective filing date of the present application is therefore December 20, 1994.

The Examiner has provided a copy of the declaration which was filed with the present application, and contends that because this declaration makes no reference to United States Serial Number 08/360,144, Applicants priority claim is unsupported. Applicants contend that this statement is simply not true. The present application was filed as a continuation of United States Serial Number 08/360,144, as indicated by Exhibit 1. Given that the present application is a continuation of United States Serial Number 08/360,144, Applicants submitted a copy of the declaration filed in that previously filed case. Submission of a previously filed declaration in a continuing application is in compliance with MPEP 602.05(a), and does not undermine the validity of Applicants' priority claim. Obviously, since this declaration is a copy of that filed in

the previously filed case, the declaration does not (and could not) refer to that previously filed case.

Applicants maintain that the present application rightfully claims priority to United States Serial Number 08/360,144, filed December 20, 1994. Accordingly, the effective filing date of the present application is December 20, 1994.

3. Applicants note with appreciation that the rejection of claims 51 and 53-54 under 35 U.S.C. 112, second paragraph, has been withdrawn.

Applicants note with appreciation that the rejection of claims 51-55, 57, 59, and 61 under 35 U.S.C. 112, second paragraph, has been withdrawn.

4. Claims 51-62 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 2, 6-7, 9, 11, 13 and 16-17 of U.S. Patent No. 6,464,974. Applicants enclose herewith a terminal disclaimer which is believed to obviate the rejection.

5. Claims 51-62 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. 103(a) as allegedly obvious over Berlin et al. (WO 95/33052). Applicants traverse this rejection.

Applicants reiterate the arguments of record in light of the remarks above regarding the priority of the instant application. Applicants respectfully point out that the cited reference is not available as prior art under 35 U.S.C. 102(b). As outlined in detail above, the present application is a continuation of U.S. Serial Number 08/360,144, now U.S. Patent No. 6,150,137, filed December 20, 1994. Given that the present application is a direct continuation of U.S. Serial Number 08/360,144, the claimed subject matter is rightfully entitled to claim priority to December 20, 1994. Accordingly, the cited reference, which became publicly accessible on December 7, 1995, is not available as prior art under 35 U.S.C. 102(b). Reconsideration and withdrawal of this rejection is respectfully requested.

Applicants further point out that the cited reference is not available as prior art under 35 U.S.C. 103(a). Firstly, as outlined in detail above, the claimed subject matter is rightfully

entitled to claim priority to December 20, 1994 – a date nearly one year **before** the publication of the cited reference. Additionally however, Applicants point out that the present application and the cited reference are the products of the same inventive entity. Given that 35 U.S.C. 103(a) requires that the cited reference is the work of “another,” Applicants contend that the cited reference is not available as prior art under 35 U.S.C. 103(a). Reconsideration and withdrawal of this rejection is respectfully requested.

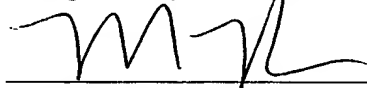
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Date: January 9, 2004

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Respectfully Submitted,



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REQUEST FOR FILING A CONTINUATION PATENT APPLICATION UNDER 37 CFR 1.53(b)(1)

DOCKET NUMBER	ANTICIPATED CLASSIFICATION OF THIS APPLICATION		PRIOR APPLICATION: EXAMINER	ART UNIT
APV-036.06	CLASS	SUBCLASS	08/360,144	1652

Address to: Box Patent Application
Assistant Commissioner for Patents
Washington, D.C. 20231

This is a request for filing a (X) continuation application under 37 CFR 1.53(b), of pending prior application Serial No. 08/360,144 filed on December 20, 1994, of:

Vivian Berlin, Maria Isabel Chiu, Guillaume Cottarel and Veronique Damagnez

Entitled: Immunosuppressant Target Proteins

Enclosed is a copy of the latest inventor signed application, including the oath or declaration as originally filed. The copy of the enclosed papers is as follows:

- 99 page(s) of specification, including 32 pages of sequence listing;
- 7 page(s) of claims;
- 1 page(s) of abstract;
- 3 sheet(s) of drawing;
- 8 page(s) of executed Declaration, Petition, and Power of Attorney including one page of Revocation and Reappointment of Power of Attorneys and one page of an Associate Power of Attorney; and
- 1 page of Verified Statement Claiming Small Entity Status.

I hereby verify that the attached papers are a true copy of the prior complete application Serial No. 08/360,144 originally filed on December 20, 1994.

The prior application is assigned of record to ARIAD Pharmaceuticals, Inc.

Please amend the specification as follows:

At page 1, line 4, after "This application", insert --is a continuation of application Serial No. 08/360,144, filed on December 20, 1994, and entitled "*Immunosuppressant Target Proteins*", which--; and
At page 100, before the claims, insert --CLAIMS:--.

The filing fee and extra claim fee is calculated as follows:

CLAIMS	NO. FILED	NO. EXTRA	RATE	CALCULATIONS
TOTAL CLAIMS (37 CFR 1.16(c))	50-20=	30	x \$18.00=	\$540.00
INDEPENDENT CLAIMS (37 CFR 1.16(b))	9-3=	6	x \$78.00=	\$468.00
MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))			+ \$270.00=	
			BASIC FEE (37 CFR 1.16(a))	+ \$690.00
Total of above Calculations =				\$1,698.00
Reduction by 50% for filing by small entity (Note 37 CFR 1.9, 1.27, 1.28)				
TOTAL=			\$849.00	